

PATENT**REMARKS**

In the Office Action, the Examiner rejected claims 1-9, 11-15 and 17-20 under 35 USC §103(a). The rejection of these claims is fully traversed below.

Claims 2-8, 15 and 18 have been amended to further clarify the subject matter regarded as the invention. Claims 1, 2-4, 9 and 11-14 have been cancelled without prejudice or disclaimer.

Claims 5-8, 15 and 17-37 remain pending in the application. Entry of this Amendment and reconsideration of the application are respectfully requested based on the following remarks.

PATENTABILITY OF CLAIMS

In the Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as unpatentable over Swab et al., U.S. Patent No. 6,929,365, in view of Jesiek, U.S. Patent No. 6,010,216 and further in view of Rydbeck, U.S. Patent No. 5,590,417; rejected claims 9, 11, 12, 15, 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and further in view of Horiguchi, U.S. Patent No. 7,031,667; rejected claims 13 and 14 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and further in view of Spitzer, U.S. Patent No. 6,091,546; and rejected claims 19 and 20 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and Horiguchi and further in view of Spitzer. These rejections are fully traversed below.

Claim 15 pertains to a pair of eyeglasses that includes a frame having a pair of arms, with wireless communication circuitry being provided within the internal area of one or both of the arms. In rejecting claim 15, the Examiner relies on a combination of Swab et al. in view of Jesiek and Horiguchi. Among other things, claim 15 recites "at least one operation indicator configured to

PATENT

indicate an operation of the wireless communication circuitry....” Further claim 15 recites:

wherein said at least one operation indicator is at least partially internal to said frame, and

wherein said at least one operation indicator being configured to indicate when said wireless communication circuitry is in use.

On page 6 of the Office Action, the Examiner admits that Swab et al. does not disclose such an operation indicator. In view of this deficiency, the Examiner combines Horiguchi with Swab et al. and Jesiek in order to reject claim 15.

Applicants disagree that the use of Horiguchi in any way overcomes the deficiencies of Swab et al. and Jesiek. Horiguchi pertains to a portable telephone, not a pair of eyeglasses. Given the distinct nature of these products, there would be no motivation for one skilled in the art to combine the portable telephone of Horiguchi with the eyeglasses of Swab et al. and Jesiek. Further, even if Horiguchi is somehow combinable with Swab et al. and Jesiek, the noncommunicative mode indicating lamp 1 of Horiguchi illuminates when the portable telephone is functioning in a noncommunicative mode (i.e., not communicating). Indeed, the expressed objective of Horiguchi is to notify persons around a user of the portable telephone that the portable telephone is functioning in the noncommunicative mode. Horiguchi, col. 3, lines 23-27. In contrast, the operation indicator as recited in claim 15 indicates operation of the wireless communication circuitry provided within the frame of the eyeglasses. Furthermore, it should also be noted that claim 15 recites “said at least one operation indicator being configured to indicate when said wireless communication circuitry is in use.” Thus, if anything, the noncommunicative mode indicating lamp 1 of Horiguchi teaches away from indicating operation of wireless communication circuitry as recited in claim 15.

Moreover, the operation indicator recited in claim 15 is part of an eyeglass frame, not a conventional portable telephone as in Horiguchi. In particular, claim 15 recites “wherein said at least one operation indicator is at least partially

PATENT

internal to said frame." The noncommunicative mode indicating lamp 1 of Horiguchi is not taught or suggested as being anyway useful or applicable on a pair of eyeglasses, let alone at least partially internal to a frame for eyeglasses as recited in claim 15.

Thus, Horiguchi fails to overcome the deficiencies of Swab et al. and Jesiek.

Accordingly, it is submitted that claim 15 is patentably distinct from any combination of Swab et al. in view of Jesiek, Rydbeck, Horiguchi and/or Spitzer. Additional limitations recited in the independent or dependent claims are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Swab et al. in view of Jesiek, Rydbeck, Horiguchi and/or Spitzer.

For example, as to claim 19, the Office Action relies on col. 11, lines 11-23 of Spitzer. However, claim 19 specifically recites that eyeglasses include a position sensor. In Spitzer at col. 11, lines 11-23 there is a discussion of a head-mounted display and obtaining position from global positioning satellites. A head-mounted display is, however, not a pair of eyeglasses. Hence, Spitzer fails to teach or suggest eyeglasses having a position sensor. Moreover, claim 20 depends from claim 19 and further recites that: "said position sensor is provided within the internal area of at least one of said arms...." Spitzer likewise lacks any teaching or suggestion for providing a position sensor within an internal area of an arm of a pair of eyeglasses. Hence, given the above-noted deficiencies of Swab et al. in view of Jesiek, Rydbeck and Horiguchi, the further combination with Spitzer for additional features in the dependent claims 19 and 20 does not remedy deficiencies of Swab et al. in view of Jesiek, Rydbeck and Horiguchi regarding the independent claims.

Thus, it is respectfully requested that the Examiner withdraw the rejections under 35 USC § 103(a).


PATENT**SUMMARY**

It is submitted that the rejections under 35 USC § 103(a) have been traversed. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-3894.

Respectfully submitted,



C. Douglass Thomas
Reg. No. 32,947

(650) 903-9200 x103